

REMARKS**I. Introduction**

Claims 4, 6, 7, 9, 17, and 18 have been examined and rejected. Upon entry of this amendment, Applicants believe that the pending claims are now in condition for allowance.

II. Response to Rejections**Rejections under 35 U.S.C. § 103**

Claims 4, 6, 7, 9, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rothschild United States Patent Number 6,651,053 (“Rothschild”) in view of Walsh United States Patent Number 6,144,848 (“Walsh”) and in further view of Knowlton United States Patent Number 6,061,057 (“Knowlton”).

A. Rejections under Rothschild

Regarding claim 17 and related claims 4 and 18, the Examiner stated that Rothschild teaches a method and system for facilitating “online ordering” comprising the steps of:

“scanning a plurality of barcodes using a barcode scanner (see at least Abstract and Figure 1); uploading said barcodes into a centralized repository; resolving each barcode into a product identifier using a product database located on said central repository (see at least Abstract, Col. 1, line 29, and Figure 5); storing the resolved information in the repository in the form of customized shopping lists; creating personalized catalogs from said shopping lists instantly, wherein said personalized catalogs include product information of items within said shopping lists along with an associated barcode, wherein said personalized catalogs may be utilized to reorder items located in said catalogs (see at least Abstract and Col. 7, lines 22-38.).” (Office Action, p. 3)

B. Applicants' Response to Rejections under Rothschild

Applicants believe that Rothschild does not teach the following steps described in Applicants' claims:

storing the resolved information in the repository in the form of customized shopping lists; creating personalized catalogs from said shopping lists instantly, wherein said personalized catalogs include product information of items within said shopping lists along with an associated barcode, wherein said personalized catalogs may be utilized to reorder items located in said catalogs.

First, Rothschild does not disclose the ability to create a "personalized catalog," especially ones that contain barcodes. In terms of Applicants' invention, a personalized catalog is defined as a catalog which is created from one of the customized shopping list. The catalog contains, among other things, a picture and/or description of the items in the list along with the item's barcode. The barcode located next to the item allows a person to easily rescan the item and add it to a shopping cart. Additionally, the personalized catalogs may be distributed around the office for use with the ordering system of the present invention. These, and other advantages of the personalized catalogs, are novel and are not disclosed anywhere in the prior art.

Additionally, while Rothschild does teach the ability to save a list of UPC codes and transfer them to other users, it does not disclose storing the lists in the form of "customized shopping lists" as is defined in Applicants' invention. Specifically, Rothschild fails to teach a method for adding and deleting items from the list after they have been scanned, or any other means of editing the lists. Rothschild also does not disclose any method of saving or organizing these lists like in Applicants' invention. The lists disclosed in Rothschild are "customized" only insofar as that the list is created by the user at the time of the scanning. No further customization abilities are disclosed at any point.

Applicants believe it is a significant advantage of their invention that a person has the ability to edit and save the scanned barcodes in different lists after they have been uploaded. These are "customized shopping lists" and not simply lists which are created

by successively scanning barcodes in a store, as is disclosed in Rothschild and the prior art.

C. Rejections under Walsh

The Examiner further argued that Walsh teaches a method for “recommending a substitute to a consumer if the product is not found in said product database by querying internal and external repositories of product and manufacturer information based on UPC codes.” The Examiner makes specific reference to the Abstract, Col. 3, lns. 24 and 52, and Col. 39, lns. 46-54.

Applicants do not find any reference to a method of recommending product substitution in the cited passages. However, Applicants notice that Walsh does contain the following passage in the specification regarding product substitution:

“At step 1412, host computer server 110 determines whether a substitute product is available that can be offered to the user. If not, the host computer server 110 proceeds with the step 1413. If a substitute item is available, host computer server 110 proceeds to step 1414.

At step 1413, host computer server 110 selects an informational message from memory or synthesizes an information message in real-time, e.g. the product so identified by the UPC code is either not-carried, or not in inventory, or may be substituted by an alternative product. The subject “availability information message” is transmitted to user device 120 for visual and/or audio presentation to the user. Applications running in host computer server 110 then proceed to execution of the step after step 1319.

At step 1414, host computer server 110 searches one or more memory databases of available goods and/or services to determine whether a substitute item is available. If not, the host computer server 110 proceeds to step 1413. If the substitute item is available, applications running in host computer server 110 proceed to step 1415.”

However, Applicants believe that while Walsh does mention that it is possible to provide a substitute product to a consumer, he does not provide any method for doing so.

Therefore, Applicants believe that Walsh provides no enabling method of performing product substitutions. This is further bolstered by the fact that Walsh does not claim this aspect in the claims because it is not fully supported by the specification.

In contrast, Applicants disclose a specific method in the specification for providing a product substitute. Specifically, Applicants state the following in the specification:

[0094] "ScanFind" refers to methods and system for searching and recommending a substitute when a product is not found in the Product Repository on a website implementing the ScanCommerce Web Application.

[0095] "ScanFind" is a component of the ScanCommerce System that will seek Substitutes for products that are either "Not Sold" or "Sold Out i.e. Not in Stock". This Component, essentially, tries to identify the product details from the UPC Code of the product that User wishes to buy; and if this product is not found in the Products Repository, compares the details of this product with the details of products available in the Product Repository; and if they match, record the product in the Repository as a Substitute of the original product searched for. For each substitute found, an entry is added to the Substitutes Table, as well as the "ScanFind Results" folder. In other words, the substitutes (substitute products) identified by the ScanFind processes are stored in the "ScanFind Results" folder in the same format as in the other folders e.g. Image, Product Name (and Description), Unit, Price, Total, and so on.

[0096] When scanned barcodes are downloaded--either automatically when the User logs in, or when the User clicks in the Download button, each downloaded codes has to be first read and searched in the Products Database. When the scanned barcode is a Scanbuy Code (SBC), there is no problem because this code would be identified (i.e. since it already exists in the Product Database). When the scanned barcode is a UPC Code, this code would be identified if it exists in the Product Database, and it will be saved in the Shopping Cart. If the UPC Code does not exist, the ScanFind component will search for the UPC code in the other databases and try to determine and recommend a substitute, as described by the process below.

[0097] The UPC code is first searched in a Substitutes table. If it is found, the SKU of the Substitute is read from the Substitutes table. This SKU is then searched in the ProductMaster table, and the product details are fetched into a variable. The Error & Substitution Message, stating that the scanned code was not found but a Substitute Product was found. The product details may be displayed and the User may be queried if s/he wishes to accept the substitute. If the User accepts the substitute, it is saved in the Cart and the next code in the list is read. In an alternative implementation, information of all substitutes may be saved in an array and all such messages may be displayed at the end rather than one by one.

[0098] If the UPC code were not found in the Substitutes table, it is first searched in an internal UPC Database; and if it is not found in the internal UPC Database, it is searched in external UPC Registries. If it is still not found in any external UPC Registry, the code is inserted in the "Not Found" folder and a "UPC Not Found!" error message displayed. The ScanFind operation terminates at this point. The Not Found folder stores the barcodes of products that were scanned but could not found in the Product Repository on the Aggregator Website. In other words, the codes that were downloaded did not match with either the UPC Codes or the SBC Codes of the products within the Product database.

Applicants believe that this passage clearly specifies how Applicants perform product substitution and provides a unique method of doing so which is not disclosed in Walsh. Applicants believe that this method of product substitution is not obvious in view of Walsh or of any of the other combinations of prior art provided by the Examiner.

D. Applicants' Invention in View of Rothschild and Walsh

Applicants believe that their invention is novel in view of Rothschild and Walsh because the prior art, either alone or in combination, fails to teach many aspects of Applicants' invention. Specifically, neither Rothschild nor Walsh discloses a method of creating personalized barcoded catalogs. Additionally, neither Rothschild nor Walsh discloses the method of recommending products substitutes which is described in Applicants' invention. Since Rothschild and Walsh do not disclose each and every element of Applicants' invention, it should be obvious that Applicants' invention is novel in view of the prior art of record.

E. Rejections under Knowlton

The Examiner argues that Knowlton teaches a method for creating a shopping cart "by dragging said shopping lists or items from said customized shopping lists and dropping them in said shopping cart; transferring said shopping cart to an e-commerce website; and using said e-commerce website to order said items located in said shopping cart."

Knowlton discloses a method of creating "visual link objects" (VLOs) and different methods of using them. In one instance, Knowlton describes a process by which

a user can drag and drop multiple VLOs into a shopping cart and then order the VLOs from the shopping cart.

Applicants believe that the drag and drop feature described in Applicants' invention is distinctly different from the one described in Knowlton. In Applicants' invention, the items are dragged and dropped from already existing shopping lists which have been made and stored. In contrast, Knowlton only discloses creating a temporary list in the shopping cart and then ordering the items. For example, if a person utilized Knowlton to order items utilizing the drag and drop technique described therein, the person would have to locate all of the VLOs and put them in the shopping cart. The VLOs would then be transported to the e-commerce website for ordering. To reorder these objects, the person would again have to aggregate all of the individual VLOs and place them in the shopping cart. Knowlton does not disclose features of Applicants' drag-and-drop technique such as the ability to drag an entire list into the shopping cart or the ability to reorder lists using drag and drop techniques. Therefore, Applicants believe that their technique of drag and drop is novel in view of Knowlton and the prior art.

F. Applicants' Invention in View of Rothschild, Walsh, and Knowlton

The Examiner argues that it would be obvious to extend the combination of Rothschild and Walsh "with a method for creating a shopping cart by dragging said shopping lists and dropping them in said shopping cart; transferring said shopping cart to an e-commerce website to order said items located in said shopping cart." As previously discussed, Applicants believe that the drag-and-drop technique of ordering products in Knowlton is distinctly different from that disclosed in Applicants' invention. Therefore, Applicants believe that the combination of Rothschild, Walsh, and Knowlton does not teach Applicants' invention as is claimed in Claims 4, 6, 7, 17 and 18.

III. Conclusion

In view of the above amendments, arguments and papers filed herewith, it is respectfully submitted that the rejections should be withdrawn. The Application is now believed to be in a condition for allowance, which is earnestly solicited.

Respectfully submitted,

Olivier Attia
